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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,183	01/28/2005	Stephen Ross Hope	AP046-05	8328
29689	7590	03/02/2006	EXAMINER	
DAVID A. GUERRA 317 - 649 MARSH ROAD N.E CALGARY, AB T2E 5B4 CANADA			MULLER, BRYAN R	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,183

Applicant(s)

HOPE, STEPHEN ROSS

Examiner

Bryan R. Muller

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/28/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 31 recites the limitation "the central pivot line" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 31 is dependent on any one of the preceding claims, but claims 1-12 do not provide a limitation of a central pivot line.
3. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kessel (6,746,311).

6. In reference to claim 1, Kessel discloses an abrasive tool (30) comprising a base portion, and a plastics film layer (35) on said base portion adapted to receive an abrasive material layer (31), wherein said base portion includes a foam layer (36) to which said plastics film layer is laminated. Kessel discloses that the sub-pad layer (36) may be made from multiple materials but provides a specific example of polyethylene foam in Example 1 (col. 6, line 60-col. 7, line 17).

7. In reference to claim 2, Kessel discloses that the abrasive material is applied to said plastics film layer.

8. In reference to claim 3, Kessel discloses that the abrasive layer comprises abrasive material (22) fixed to a backing layer (33) wherein said backing layer is applied to the plastic film layer.

9. In reference to claim 4, Kessel discloses that said backing layer is provided with an adhesive to attach the abrasive material layer to the film layer (Example 1; col. 6, line 60-col. 7, line 17).

10. In reference to claim 6, Kessel discloses that said foam layer may be made of polyethylene foam, as discussed supra.

11. In reference to claim 7, Kessel discloses that the plastics film layer may be formed polyethylene or polypropylene films (col. 3, lines 58-66).

12. In reference to claim 8, the claim appears to be a process by which the product is made, making this a product by process claim, in which determination of patentability is based on the product itself, the patentability of a product does not depend on its method of production and if the product in the product-by-process claim is the same as or

obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP §2113 [R-1]). The claim does not provide any further structure to the product, and is therefore anticipated by Kessel, as discussed supra.

13. Claims 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rawley (3,123,947).

14. In reference to claim 17, Rawley discloses an abrasive tool comprising a handle portion (20, 26 and 28), a flexible base portion (10) connected to the handle portion about a central pivot line (center of 16), and adjustment spacing means (20, 22 and 23) provided at respective spaced apart ends of the handle portion, between the handle and base (at least a portion of the adjusting means is always between the handle and the base) portions for adjustably fixing the distance between the handle and base portions at either end of the handle portion to thereby adjust the curvature of the base portion.

15. In reference to claim 18, the curvature of the flexible base portion of Rawley may inherently be concave or convex.

16. In reference to claim 19, Rawley discloses that the adjustment means is a pivotable connection (about 24) with a respective end of the flexible base portion.

17. In reference to claim 20, Rawley discloses that each said adjustment means comprises a screw member (22) passing through a respective end of the handle portion (20) and received within a socket (portion 20 of the handle comprises a socket that receives the screw member) pivotably connected to a respective end of the flexible portion. The socket is part of the handle, which is threadably attached to the screw

member, which is pivotably attached to the end of the flexible base portion, thus each socket is pivotably connected to a respective end of the flexible base portion.

18. In reference to claim 21, Rawley discloses that each socket is pivotable (via, the screw member, as discussed supra) about a rod (24) fixed within an end (14) of the flexible base portion, wherein the rod is fixed to the flexible base portion substantially across the entire width of the flexible base portion. The rod is affixed to part 14, which is substantially affixed across the entire width of the base portion by way of part 13.

Claim Rejections - 35 USC § 102/103

19. Claim 5 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kessel (6,746,311).

20. Kessel discloses that the backing layer is provided with an adhesive to attach the abrasive layer to the film layer (via a polycarbonate surface in Example 1) col. 7, lines 5-15) but Kessel does not specifically disclose that the adhesive is a pressure sensitive adhesive. However, Kessel does disclose that other adhesives in the laminated abrasive tool are pressure sensitive adhesives (col. 6, lines 60-65), thus it would be obvious that the adhesives used for the entire tool would be pressure sensitive adhesives.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 9-16 and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rawley (3,123,947) in view of Kessel (6,746,311).

23. Rawley discloses the abrasive tool, as discussed supra, and provides a clamping mechanism to attach abrasive material layer to the handle and base portion and Kessel discloses the abrasive tool, as discussed supra, wherein the abrasive material layer is attached to the base using an adhesive release layer, that may be made of polyethylene or polypropylene film coated with a low adhesion backing material and discloses that the base may include a backing pad, which is commonly known in the art to provide padding for the abrasive layer to prevent the abrasive layer from ripping or tearing and to allow the abrasive layer to at least partially conform to the work piece. Kessel also teaches that the inclusion of the release layer reduces the effort, time and cost involved with pad replacement (col. 1, lines 63-65) and that the polishing surface (abrasive layer) may easily be removed from a release layer, leaving at least a portion of the sub-pad still attached to the polishing device (tool) once the abrasive layer becomes unusable and a new abrasive layer may be attached, thus only portions of the tool that require replacement are removed, thereby simplifying and reducing the cost of equipment (col. 2, lines 2-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the flexible base of the Rawley tool, with

a backing pad, as taught by Kessel, to prevent the abrasive layer from ripping or tearing and to allow the abrasive layer to at least partially conform to the work piece and to provide a release layer between the backing pad and the abrasive layer, also taught by Kessel, to reduce the effort, time and cost involved with replacing the abrasive layer.

24. In reference to claims 9-16, the obvious combination of Rawley and Kessel will provide the abrasive tool, having a base portion, and a plastics film layer on said base portion adapted to receive an abrasive material layer, wherein said base portion includes a foam layer to which said plastics film layer is laminated along with all the limitations of claims 1-8, as discloses by Kessel, as discussed supra, and the tool of Rawley comprises all the limitations of claims 9-16, as discussed supra.

25. In reference to claims 22-30, the tool of Rawley discloses all of the limitations of claims 17-21, as discussed supra and the Kessel reference discloses all of the individual limitations of claims 22-30, as discussed supra, therefore the obvious combination of Rawley and Kessel provide all of the limitations set forth in claims 22-30), making the claims obvious in view of Rawley and Kessel.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coon et al (3,710,467) and Balbi (5,700,187) both disclose abrasive tool with a flexible base that have adjusting means for adjustably fixing the distance between the handle and base portion at either end of the handle portion to adjust the curvature of the base portion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan R. Muller whose telephone number is (571) 272-4489. The examiner can normally be reached on Monday thru Thursday and second Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BRM *BRM*
2/28/2006



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